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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
001/001	12/15/00	BUHR	GLIS-0128

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12/15/00

EXAMINER

OWENS JR, H

ART UNIT PAPER NUMBER

1523

*5*

DATE MAILED:

12/15/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**09/408,396**

Applicant(s)

**Buhr et al.**

Examiner

**Howard Owens**

Group Art Unit

**1623**



☐ Responsive to communication(s) filed on \_\_\_\_\_

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-26 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☒ Claim(s) 1-8 is/are allowed.

☒ Claim(s) 9-26 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1623

*Reissue Application*

**Objections**

This application is objected to under 37 CFR 1.172(a) as lacking the written consent of all assignees owning an undivided interest in the patent. The consent of the assignee must be in compliance with 37 CFR 1.172. See MPEP § 1410.01.

A proper assent of the assignee in compliance with 37 CFR 1.172 and 3.73 is required in reply to this Office action.

Claim 11 appears to contain the misspelled word “benzoyladeneine”. Appropriate correction is required for this and any other spelling or grammatical errors not noted herein.

**Oath/Declaration**

The reissue oath/declaration filed with this application is defective because it fails to contain a statement that all errors which are being corrected in the reissue application up to the time of filing of the oath/declaration arose without any deceptive intention on the part of the applicant. See 37 CAR 1.175 and MPEP § 1414.

**Specification**

The specification is objected to because cut - up soft copies of the original patent, with only a single column of the printed patent securely mounted on a separate sheet of paper, may be used in preparing the reissue specification and claims to be filed (see MPEP 1411).

**Reference Forms**

The references cited in the patent are not re-cited in the reissue. The list of references to be printed at the end of the reissue specification should include both the references cited during the original prosecution as well as the references cited during the prosecution of the reissue application (See MPEP 1455).

**Claim Objections**

Newly added claim 10 appears to contain the misspelled term "benzoyladeneine". Correction is required for this and any other spelling or grammatical errors not noted herein.

**35 U.S.C. 112(2)**

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Newly added claims 9-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Use of the term "general" implies that the compound is not confined by specialization to the claimed structure or substituents thereof. As claimed, the ribonucleoside is selected from the specific substituents and core structures set forth in the instant application, these core structures and substituents can not be general in structure or substituents, but must be specific or defined to that which is claimed.

35 U.S.C. 103

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claims 20-26 are rejected under 35 U.S.C. § 103 as being unpatentable over Gait, *Oligonucleotide Synthesis: A practical approach*, October, 1984 in combination with Sterzycki et al., EP 0316017 A2.

Claims 20-26 are drawn to a modified oligonucleotide or derivative thereof comprising at least one nucleoside selected from the group consisting of a 2'-deoxy-2'-fluoro-ribonucleoside, an arabinonucleoside, a 2'-deoxy-arabinonucleoside and a 2'-deoxy-2'-fluoro-arabinonucleoside.

Sterzycki et al. teach 2'-deoxy-2'-fluoro-arabinonucleosides and derivatives thereof (pp. 2 and 8-10). However, Sterzycki et al. does not teach the formation of oligonucleotide formation from the 2'-deoxy-2'-fluoro-arabinonucleosides. The formation of oligonucleotides from nucleoside compounds is well known in the art. Gait teaches the synthesis of oligodeoxynucleotides from deoxyribonucleosides as well as the phosphorothiate and phosphoramidite internucleotide linkages.

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It would have been prima facie obvious to synthesize an oligonucleotide from a modified 2'-deoxy-2'-fluoro-deoxyoligonucleotide or derivative thereof.

A person of ordinary skill in the art would have been motivated to produce the oligonucleotides from deoxynucleosides of the instant claims for the art recognized benefit of the construction, selection and determination of the DNA sequence of recombinants or site directed mutagenesis.

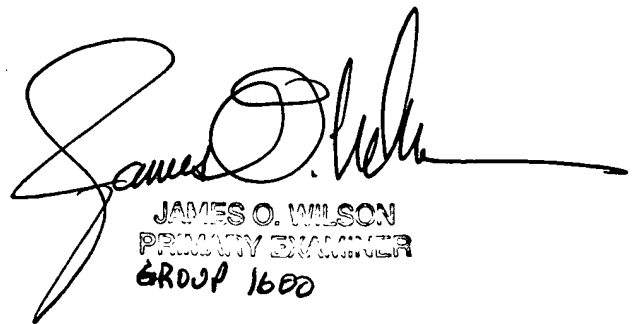
Applicant has broadly set forth classes of nucleoside compounds which as instantly claimed do not particularly denote novel compounds. Moreover, given the state of the art with regards to the synthesis of oligonucleotides, one of skill in the art would have a reasonable expectation of success in the formation of oligonucleotides from the broad classes of compounds set forth in the instant claims.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Howard Owens whose telephone number is (703) 306-4538 . The examiner can normally be reached on Mon.-Fri. from 8:30 a.m. to 5 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the Primary Examiner signing this action, James O. Wilson can be reached on (703) 308-4624 . The fax phone number for this Group is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.



JAMES O. WILSON  
PRIMARY EXAMINER  
GROUP 1600